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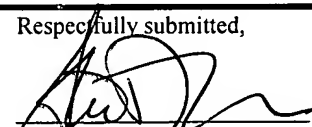
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| TRANSMITTAL FORM  | Application Serial Number | 10/729,045 |
| | Filing Date | December 5, 2003 |
| | First Named Inventor | Lovenstein, <i>et al</i> |
| | Group Art Unit | 2854 |
| | Examiner Name | Marissa L. Ferguson |
| | Attorney Docket No. | PTK-235 |
| | Patent No. | Not applicable |
| | Issue Date | Not applicable |

ENCLOSURES (check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Check Attached <input type="checkbox"/> Copy of Fee Transmittal Form <input type="checkbox"/> Amendment/Response <input type="checkbox"/> Preliminary <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Letter to Official Draftsperson including Drawings [Total Sheets ____] <input type="checkbox"/> Petition for Extension of Time <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Form PTO-1449 <input type="checkbox"/> Copies of IDS Citations <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Sequence Listing submission <input type="checkbox"/> Paper Copy/CD <input type="checkbox"/> Computer Readable Copy <input type="checkbox"/> Statement verifying identity of above | <input type="checkbox"/> Copy of Notice to File Missing Parts of Application (PTO-1553) <input type="checkbox"/> Formal Drawing(s) <input type="checkbox"/> Request For Continued Examination (RCE) Transmittal <input type="checkbox"/> Power of Attorney (Revocation of Prior Powers) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Executed Declaration and Power of Attorney for Utility or Design Patent Application <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> CD(s) for large table or computer program <input type="checkbox"/> Amendment After Allowance <input type="checkbox"/> Request for Certificate of Correction <input type="checkbox"/> Certificate of Correction (in duplicate) | <input type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences <input type="checkbox"/> Appeal Brief (in triplicate) <input type="checkbox"/> Status Inquiry <input checked="" type="checkbox"/> Return Receipt Postcard <input type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8 <input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8 <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below) - Reply Brief (in triplicate) |
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| CORRESPONDENCE ADDRESS | SIGNATURE BLOCK |
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| Direct all correspondence to: Patent Administrator Goodwin Procter LLP Exchange Place Boston, MA 02109 Tel. No.: (617) 570-1000 Fax No.: (617) 523-1231 Customer No. 051414 | Respectfully submitted,  Date: August 29, 2006 Reg. No. 33,497 Tel. No.: (617) 570-1241 Fax No.: (617) 523-1231 Steven J. Frank Attorney for Applicants Goodwin Procter LLP Exchange Place Boston, MA 02109 |



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PATENT
Atty. Docket No. PTK-235

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Lovenstein et al. CONFIRMATION NO.: 9318
SERIAL NUMBER: 10/729,045 ART UNIT: 2854
FILING DATE: December 5, 2003 EXAMINER: M. Ferguson
TITLE:

MAGNETIC PLATE RETENTION

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Status of Claims

The application as filed contained 10 claims. Pending claims 1-10 have been finally rejected and are the subject of this appeal.

Grounds of Rejection Addressed Herein

This reply brief is submitted pursuant to 37 C.F.R. §41.41 in reply to the Examiner's Answer of June 30, 2006 (the "Answer"). In particular, this brief addresses the following points raised by the Examiner against the patentability of Appellants' claims:

- The assertion that the *top* surfaces 56, 57 of Kerr are relevant to the present claims;¹ and
- The assertion that "Zerillo appears to teach a curved retention device."²

For the reasons that follow, we respectfully submit that Kerr does not teach a curved surface relevant to the claimed subject matter, and that Zerillo does not teach a curved retention device at all.

¹ Answer at pg. 5.

² *Id.*

Arguments

I. The Top Surfaces 56, 57 of Kerr are Irrelevant to the Present Claims

In the Answer, the Examiner asserts that “the retainer device of Kerr as a whole shows a curvature,” and that “surfaces 56, 57 [follow] the curved surface of the drum (28), thereby retaining the sheet material.”³

In specifying surfaces 56, 57, the Examiner appears to refer not to the *top* surface of the fixture 50, which in fact *does* exhibit curvature, but to the *underlying* surface portions opposite the flat tops of slides 66. As is readily apparent from the figures (particularly FIG. 15b, relied upon by the Examiner in the Answer), the underlying surface portions of fixture 50 that oppose the flat tops of slides 66 *are themselves flat*. Accordingly, the Examiner is simply incorrect in characterizing these surfaces as curved.

Referring in the alternative to the “retainer device of Kerr as a whole” does not help the Examiner’s case. While the *top* surface of fixture 50 is curved, that is not the surface that “retain[s] the sheet material” (per the Examiner’s characterization).⁴ And as the Examiner implicitly recognizes, that is also not the surface relevant to the present claims, since these call for a curved surface with which “at least one magnetic element” is “associated.” There is no magnetic element associated with the *top* surface of fixture 50.

Accordingly, the Examiner has failed to identify any relevant disclosure in Kerr that could be combined with Zerillo to meet the limitations of Applicants’ claims. Kerr’s retention surfaces are flat. So are Zerillo’s. Combining them does not create a curved surface as claimed.

II. Zerillo Does Not Teach a Curved Retention Device

In characterizing Zerillo, the Examiner acknowledges that this patent “does not explicitly teach” a curved surface.⁵ But then, contradicting this admission, the Examiner states her belief

³ *Id.*

⁴ *Id.*, last full paragraph, third line.

⁵ *Id.*, first full paragraph, fifth line; Answer at page 6, lines 6-7.

that Zerillo *does*, in fact, “appear[] to teach a curved retention device.”⁶ The Examiner cannot have it both ways. A surface is either curved or it is not; a reference either teaches a limitation or it does not. Even a cursory inspection of the figures highlighted by the Examiner — she cites FIGS. 1, 4, and 5, and later FIGS. 3 and 5 — reveals nothing to suggest a curved surface. Quite the opposite: FIG. 3 of Zerillo, *shown in the Examiner’s Answer* at page 7, illustrates a flat retention base 95; and FIG. 8 shows magnetic elements 90 with flat surfaces. Indeed, the undersigned, having been involved in the drafting of the Zerillo patent and having personally viewed the device described therein, can confirm that neither the elongated retention base 95 of retention device 50 nor the magnetic elements 90 has a curved surface.

In sum, the Examiner is simply wrong or she is speculating impermissibly. The Federal Circuit has repeatedly held that the relevance of a reference cannot be predicated on “mere conjecture.” *In re Robinson W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851, 105 S.Ct. 172 (1984); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Conclusion

Appellants respectfully submit that the Examiner has failed to meet her burden of establishing that the limitations of the present claims, which require a curved surface that is complementary to the curvature of a cylinder and associated with a magnetic device, are met by the references of record — alone or in combination. Appellants therefore request the Board of Patent Appeals and Interferences to reverse the Examiner’s rejections and direct that this application be passed to issuance.

⁶ Answer at page 5, first full paragraph, fourth line; *see also* page 6, lines 5-6 (“It appears, however, that the retaining element of Zerillo is curved”).

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven J. Frank', written over a horizontal line.

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